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sequence number and presenting the obtained information.

## **REMARKS**

In the Office Action mailed on December 31, 2001, claims 1, 10, and 11 were rejected under 35 U.S.C. § 102(e) as being anticipated by Borman et al. (U.S. Patent No. 5,890,172) ("Borman"); claims 2-7 and 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Borman; and claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Borman in view of Gorbet et al. (U.S. Patent No. 6,072,480) ("Gorbet") and Qureshi et al. (U.S. Patent No. 6,084,582) ("Qureshi"). The foregoing rejections are respectfully traversed.

Claims 1-14 are pending in the subject application, of which claims 1 and 12-14 are independent. Claims 2-11 depend, directly or indirectly, from claim 1. The specification and claims 1-14 are amended. Care has been exercised to avoid the introduction of new matter. A Version With Markings To Show Changes Made to the specification and amended claims is included herewith.

## Rejection Under 35 U.S.C. § 102(e) (Borman):

Borman discloses a computer-implemented system for retrieving information through a browser connected to a network (Borman, Abstract). The system parses through a hypertext document (such as an Internet web page) for hyperlinks and compiles a list of the hyperlinks contained therein (Borman, Summary). They system then does one of three things: (a) the system navigates to one of the first, prior, next, or last hyperlink in the list in response to a command by the user to navigate to another hyperlink; (b) the system automatically navigates to each hyperlink in order after a predetermined interval; or (c) the system navigates to a hyperlink that is chosen by a user and displays the list of non-chosen hyperlinks in the same display, so that the user can select one of the other original hyperlinks from the list without having to backtrack (Borman, Summary).

In contrast, claim 1 of the present application (as amended herein) recites "a control unit to inform the address information to the browser unit according to a predetermined output sequence that is specified by a user, and to instruct output of information corresponding to the

informed address information." (emphasis added) Borman does not disclose or suggest informing an address information to a browser unit according to a predetermined output sequence that is specified by a user. In fact, Borman only discloses navigating sequentially through a list of hyperlinks that was created by the system or navigating through a list of hyperlinks at the direction of a user as the user selects the next hyperlink for navigation when a current hyperlink is being displayed. MPEP § 2131 states that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ... claim." (emphasis added) Clearly, Borman does not anticipate claim 1; therefore, claim 1 is allowable.

In addition to being allowable based on their dependency from allowable claim 1, claims 10 and 11 of the present application (as amended herein) recite patentably distinguishing features of their own. For example, claim 11 recites "a storage unit to store information to be outputted corresponding to address information." (emphasis added) Borman does not disclose or suggest storing information to be outputted. Borman discloses storing parsed HTML files (Borman, col. 6, lines 2-3). According to the system in Borman, parsed HTML files include "an advertisement, a plurality of URLs and topic descriptors corresponding to each URL" (Borman, col. 6, lines 30-32). In the present invention, the information to be outputted that is stored includes a web page to be displayed (Specification, p. 10, lines 6-9). The "URLs and topic descriptors corresponding to each URL" that are stored in Borman are not web pages, but merely the addresses thereof. In the present invention, the storage of a web page to be outputted is advantageous because the system need not be connected to a network during a presentation, and will therefore not be interrupted by connection failure (Specification, p. 10, lines 18-24). Because Borman only discloses storing URLs and their topic descriptors, it does not anticipate storing the information to be outputted. Therefore, claims 10 and 11 are allowable.

## Rejection Under 35 U.S.C. § 103(a) (Borman):

The remarks set forth above are incorporated as if fully set forth herein. In addition, claims 12-14 of the present application (as amended herein) recite "a correspondence relationship between a plurality of pieces of address information defined on an information

network and a plurality of sequence numbers of a predetermined output sequence that is specified by a user." (emphasis added) Borman only discloses the three options listed above ((a) – (c)). Although the rejection, in item 5 on page 7 of the Office Action, states that "it would have been obvious to use sequence numbers corresponding with Borman's slide-show, to display information," it is not obvious to use a predetermined output sequence that is specified by a user, as recited in claims 12-14. In Borman, the sequence followed in option (b) (the relevant option for purposes of claims 12-14) is sequential and determined by the order in which the URLs were parsed by the system. In claims 12-14, the sequence is predetermined by the user, and can be in any order. The options (a) and (c) in Borman are not relevant to claims 12-14 because in (a) and (c), although a sequence of URLs is user-specified, the system is not automatically navigating to each URL per that sequence; rather, the system is navigating to the next URL when and as chosen by the user in real time. Claims 12-14 allow a user to specify the display order specifically, by revising the predetermined output sequence. For example, a user of claims 12-14 can predetermine the output sequence of display for a slide show presentation. and is not required to manually advance the slide show in real time (as in (a) and (c) of Borman) or to follow the sequence as compiled by the system (as in (b) of Borman). Clearly, claims 12-14 patentably distinguish over Borman and are allowable.

In addition to being allowable based on their dependency, directly or indirectly, from claim 1, claims 2-7 of the present application (as amended herein) recite patentably distinguishing features of their own. For example, claim 2 recites "a storage unit to store a *user-specified* correspondence relationship between a plurality of pieces of address information and a plurality of sequence numbers representing the output sequence." (emphasis added) The rejection, in item 5 on page 4 of the Office Action, states that it would have been obvious to use sequence numbers to know the correct succession of HTML files to load. However, claim 2 recites that the plurality of sequence numbers is user-specified. MPEP § 706.02(j) requires that, for a rejection under § 103, "the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." Borman does not disclose or suggest a user-specified plurality of sequence numbers is not obvious from the system in Borman based on options (a) – (c). As discussed above, option (b) in Borman is the only alternative where the system automatically navigates through the list of

URLs, and the sequence is not user-specified. In options (a) and (c), the user specifies the sequence, but only in real time. Claim 2 recites storing a user-specified correspondence relationship between the sequence and the pieces of address information. Again, as stated above, claim 2 permits the user to specify a sequence for display that may differ from the system's compilation of the pieces of address information, for example, in preparing a slide show, and have the system display the sequence automatically without the user's real time input. Clearly, claims 2-7 are not disclosed or suggested by Borman, and are therefore allowable.

# Rejection Under 35 U.S.C. § 103(a) (Borman, Gorbet, and Qureshi):

Gorbet discloses a mechanism for designating, creating, and playing custom music soundtracks to accompany an electronic slide show (Gorbet, col. 3, line 66 – col. 4, line 1).

Qureshi discloses a mechanism for recording audio, and in particular audio narration, to accompany a set of slides stored on a computer storage medium (Qureshi, col. 3, lines 35-37).

The combination of Borman, Gorbet, and Qureshi discloses a computer-implemented system for retrieving information through a browser connected to a network. The system parses through a hypertext document (such as an Internet web page) for hyperlinks and compiles a list of the hyperlinks contained therein. The system plays audio music or narration while navigating the list of hyperlinks in one of three ways: (a) the system navigates to one of the first, prior, next, or last hyperlink in the list in response to a command by the user to navigate to another hyperlink; (b) the system automatically navigates to each hyperlink in order after a predetermined interval; or (c) the system navigates to a hyperlink that is chosen by a user and displays the list of non-chosen hyperlinks in the same display, so that the user can select one of the other original hyperlinks from the list without having to backtrack.

In contrast, and in addition to being allowable based on their dependency, directly or indirectly, from claim 1, claims 8 and 9 of the present application (as amended herein) recite patentably distinguishing features of their own. For example, claim 9 recites that "the control unit determines sound information to be outputted according to a user-specified sequence number of the address information representing the output sequence." (emphasis added) The combination of references does not disclose or suggest determining sound information to be outputted according to a sequence number of the address information. The rejection, in item 6

on page 9 of the Office Action, states that it would have been obvious to use a sequence number for outputting the sound information. However, in claim 9, the sequence number is user-specified, and the combination of references does not disclose or suggest a user-specified sequence number (see discussion in regards to Borman, above). Therefore, claims 8 and 9 are not rendered obvious by the combination of references and are therefore allowable.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited. Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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#### **VERSION WITH MARKINGS TO SHOW CHANGES MADE**

### IN THE SPECIFICATION:

Please AMEND the paragraph beginning at page 5, line 10, as follows:

--The browser unit obtains information using address information defined on an information network and outputs the thus-obtained information. The control unit informs the address information to the browser unit according to a predetermined output sequence <a href="mailto:specified">specified</a> <a href="mailto:by a user">by a user</a> and instructs the output of information corresponding to the [thus-informed] <a href="mailto:informed">informed</a> address information.--

Please AMEND the paragraph beginning at page 5, line 20, as follows:

--This processing includes [a step of] referring to a correspondence relationship between [one or more] a plurality of pieces of address information defined on the information network and a plurality of sequence [number] numbers representing a predetermined output sequence specified by a user, and [a step of] informing the address information corresponding to the current sequence number to the browser unit so that the output of information corresponding to the [thus-informed] informed address information is instructed.--

Please AMEND the paragraph beginning at page 6, line 7, as follows:

--This processing includes [a step of] referring to a correspondence relationship between [one or more] a plurality of pieces of address information defined on the information network and a plurality of sequence [number] numbers representing a predetermined output sequence specified by a user, [a step of] obtaining information using the address information corresponding to the current sequence number, and [a step of] outputting the [thus-obtained] obtained information.--

## IN THE CLAIMS:

Please AMEND the following claims:

1. (ONCE AMENDED) A slide show system comprising:

<u>a</u> browser [means for] <u>unit</u> [obtaining] <u>to obtain</u> information using address information defined on an information network, and [for] [outputting] <u>to output</u> the [thus-obtained] <u>obtained</u> information; and

<u>a</u> control [means for] <u>unit</u> [informing] <u>to inform</u> the address information to the browser [means] <u>unit</u> according to a predetermined output sequence <u>that is specified by a user</u>, and [for] [instructing] <u>to instruct</u> output of information corresponding to the [thus-informed] <u>informed</u> address information.

2. (ONCE AMENDED) The slide show system according to claim 1, further comprising:

<u>a</u> storage [means for] <u>unit</u> [storing] <u>to store</u> a <u>user-specified</u> correspondence relationship between [at least one piece] <u>a plurality of pieces</u> of address information and [a] <u>a plurality of sequence</u> [number] <u>numbers</u> representing the output sequence, wherein

the control [means] <u>unit</u> refers to the correspondence relationship and determines address information to be informed to the browser [means] <u>unit</u>.

3. (ONCE AMENDED) The slide show system according to claim 2, further comprising:

<u>an</u> operation [means for] <u>unit</u> [allowing] <u>to allow</u> [a] <u>the</u> user to specify information to be outputted next, wherein

the control [means] <u>unit</u> informs address information corresponding to the [thusspecified] <u>specified</u> information by the operation [means] <u>unit</u> to the browser [means] <u>unit</u>.

- 4. (ONCE AMENDED) The slide show system according to claim 3, wherein the operation [means] <u>unit</u> specifies one of <u>the address</u> information pieces before and after information currently being outputted as the information to be outputted next.
- 5. (ONCE AMENDED) The slide show system according to claim 2, wherein the control [means] <u>unit</u> informs the [at least one piece] <u>plurality of pieces</u> of address information to the browser [means] <u>unit</u> according to the output sequence.
- 6. (ONCE AMENDED) The slide show system according to claim 5, wherein the control [means] <u>unit</u> informs the [at least one piece] <u>plurality of pieces</u> of address information to

the browser [means] unit at prescribed time intervals.

7. (ONCE AMENDED) The slide show system according to claim 6 wherein the control [means] <u>unit</u> changes the time intervals according to <u>each of</u> the <u>plurality of</u> sequence [number] <u>numbers</u>.

8. (ONCE AMENDED) The slide show system according to claim 1, further comprising:

<u>a</u> sound output [means for] <u>unit</u> [outputting] <u>to output</u> sound information including at least one of music and a narration, wherein

the control [means] <u>unit</u> instructs the sound output [means] <u>unit</u> to output the sound information.

- 9. (ONCE AMENDED) The slide show system according to claim 8, wherein the control [means] <u>unit</u> determines sound information to be outputted according to [the] <u>a user-specified</u> sequence number of <u>the</u> address information representing the output sequence.
- 10. (ONCE AMENDED) The slide show system according to claim 1, wherein the browser [means] <u>unit</u> obtains information via a communication network using address information informed by the control [means] unit.
- 11. (ONCE AMENDED) The slide show system according to claim 1, further comprising:

<u>a</u> storage [means for] <u>unit</u> [storing] <u>to store</u> information to be outputted corresponding to address information, wherein

the browser [means] <u>unit</u> obtains information which is stored in the storage [means] <u>unit</u> using address information informed by the control [means] <u>unit</u>.

12. (ONCE AMENDED) A computer-readable storage medium which stores a program for causing a computer to [execute the steps of] perform functions comprising:

referring to a correspondence relationship between [at least one piece] <u>a plurality of pieces</u> of address information defined on an information network and [a] <u>a plurality of sequence [number] numbers</u> of a predetermined output sequence <u>that is specified by a user;</u> and

informing address information corresponding to a current sequence number to a browser, and instructing output of information corresponding to the thus-informed address information.

13. (ONCE AMENDED) A computer-readable storage medium which stores a program for causing a computer to [execute the steps of] perform functions comprising: referring to a correspondence relationship between [at least one piece] a plurality of pieces of address information defined on an information network and [a] a plurality of sequence

obtaining information using address information corresponding to a current sequence number; and

[number] <u>numbers</u> of a predetermined output sequence that is specified by a user;

outputting the [thus-obtained] obtained information.

14. (ONCE AMENDED) A slide show method comprising [the steps of]:

preparing a correspondence relationship between [at least one piece] a plurality of

pieces of address information defined on an information network and [a] a plurality of sequence

[number] numbers of a predetermined output sequence that is specified by a user;

obtaining address information corresponding to a current sequence number with reference to the correspondence relationship;

obtaining information using the address information corresponding to the current sequence number; and

presenting the [thus-obtained] obtained information.